

### **REMARKS**

Amendment B is hereby provided after careful consideration of the Examiner's comments set forth in the Office Action mailed December 7, 2010. Claims 1-21 remain in the application and claims 22-25 are added after Amendment B is entered. Reconsideration of the application is respectfully requested in view of the amendments and remarks provided herein.

### **The Office Action**

Claims 6, 8, and 15 are objected to for not having the appropriate status indication in view of being previously amended in a Preliminary Amendment filed along with entry into the U.S. during the national stage of PCT Pat. Application No. PCT/GB2003/004596.

Claims 1-21 stand rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement because the specification allegedly does not support the "non-programmable" term in claims 1, 7, 9-12, 12, and 16-21.

Claims 1-21 stand rejected under 35 U.S.C. § 112, second paragraph for indefiniteness because use the "non-programmable" term in claims 1, 7, 9-12, 12, and 16-21 is allegedly inconsistent with the common meaning.

Claims 17, 19, and 20 stand rejected under 35 U.S.C. § 102(e) for allegedly being anticipated by U.S. Patent No. 7,124,938 to Marsh.

Claims 1-4, 6, 8-13, 15-16, and 19-21 stand rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Marsh in view of "WinTV-USB and WinTV-USB-FM Specification" by Hauppauge.

Claim 5 stands rejected under 35 U.S.C. § 103(a) for allegedly being obvious over Marsh and Hauppauge in view of U.S. Pat. App. Publication No. 2002/0169973 to Kim et al.

Claims 7, 14, and 18 are identified as allowable dependent claims that would be allowed if placed in independent form including all of the limitation of the base claim and any intervening claims.

## **The Objections**

### **Claims 6, 8, and 15 are in Proper Form.**

Amendment A identified the status indicators for claims 6, 8, and 15 as "Original." The status indicators for claims 6, 8, and 15 are changed to "Previously presented" in this Amendment B. Based at least on the foregoing, the Applicant respectfully submits that claims 6, 8, and 15 are in proper form. Accordingly, the Applicant respectfully requests that the corresponding objections be withdrawn.

### **The § 112, 1<sup>st</sup> Paragraph Rejection**

#### **Claim 1-21 are Properly Supported by the Written Description.**

Claims 1, 7, 9-12, 14, and 16-21 are amended to delete the "non-programmable" term for which the § 112, first paragraph rejections were raised. Accordingly, the Applicant respectfully requests that the § 112, first paragraph rejections of claims 1-21 be withdrawn.

### **The § 112, 2<sup>nd</sup> Paragraph Rejections**

#### **Claims 1-21 Are No Longer Indefinite.**

Claims 1, 7, 9-12, 14, and 16-21 are amended to delete the "non-programmable" term for which the § 112, second paragraph rejections were raised. Accordingly, the Applicant respectfully requests that the § 112, second paragraph rejections of claims 1-21 be withdrawn.

### **The § 102 Art Rejections**

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). In order for the reference to anticipate a claim, it must teach every element of the claim. See MPEP § 2131.

**Claims 17, 19, and 20 Patentably Distinguish Over Marsh.**

As amended, independent claim 17 is directed to a games console that includes "a console housing; a game interface within said console housing for receiving a game product; a display interface within said console housing for interfacing said games console to a display; a user interface within said console housing for receiving user input; a game controller within said console housing for receiving game data from said game interface and said user input from said user interface and for generating therefrom game video data for output to said display interface; an adaptor interface within said console housing for coupling the games console with said adaptor unit; a memory within the console housing for storing software modules; and a processor within the console housing for executing software modules stored in the memory; wherein the games console is operable to i) receive a video player software module from the adaptor unit, ii) store the video player software module in the memory, iii) use the processor to execute the video player software module, iv) receive encoded video data from the adaptor unit, and v) use the video player software module to generate decoded video data from the received encoded video data for output to a display via the display interface." This anticipation rejections in reliance on Marsh is clear error because the reference does not disclose or fairly suggest the "game controller" element or the "wherein" clause.

As for the "game controller" element, the Office Action cites col. 5, line 64 - col. 6, line 16 and FIG. 2 of Marsh for disclosure of this element. However, the cited portions of Marsh merely disclose data processors of a computer that are programmed by instructions stored at different times in various storage media of the computer. The Marsh computer may be programmed via various methods and techniques. Certain sub-components of the Marsh computer may be programmed to perform certain functions and steps.

Notably, the cited portions of Marsh do not disclose or fairly suggest a games console that includes a game controller that generates game video data based on received game data and received user input as recited in the "game controller" element

of claim 17. Rather, the cited portions of Marsh simply disclose a basic computer with sub-components that may be programmed for certain functions.

As for the "wherein" clause, this clause was added to claim 17 in this amendment. Therefore, the new "wherein" clause is not directly addressed in the Office Action. Limitations similar to those presented in the "wherein" clause were previously presented in a "video player" element of claim 17. The previously presented "video player" element is deleted in this amendment. This argument for the "wherein" clause addresses the Office Action citations for the previously presented "video player" element. Like the "game controller" element, the Office Action cited col. 5, line 64 – col. 6, line 17 of Marsh for disclosure of the previously presented "video player" element. Therefore, the disclosures of Marsh identified above in the arguments distinguishing the "game controller" element also apply to arguments distinguishing the "wherein" clause.

Notably, the cited portions of Marsh do not disclose or fairly suggest a games console that receives a video player software module from an adaptor unit, stores the video player software module in a memory, uses a processor to execute the video player software module, receives encoded video data from the adaptor unit, and uses the video player software module to generate decoded video data from the received encoded video data for output to a display as recited in the "wherein" clause of claim 17. Rather, the cited portions of Marsh simply disclose a basic computer with sub-components that may be programmed for certain functions.

Based at least on the foregoing, it is submitted that claim 17 is patentably distinguished from Marsh. Accordingly, the Applicant respectfully submits that independent claim 17 and claims dependent thereon (e.g., claims 19 and 20) are currently in condition for allowance.

### **The § 103 Art Rejections**

Obviousness rejections are based on the statutory language that "a patent may not be obtained ... if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." See 35 U.S.C. § 103(a). The key to supporting any obviousness rejection is the clear

articulation of the reason(s) why the claimed invention would have been obvious. See MPEP § 2142. The analysis supporting an obviousness rejection should be made explicit. See *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007). Rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. See *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

**Claims 1-4, 6, and 8-10 Patentably Distinguish Over the Combination of Marsh and Hauppauge.**

As amended, independent claim 1 is directed to a games system that includes “a games console and an adaptor unit.” The games console includes “(i) a console housing; (ii) a game interface within said console housing for receiving a game product; (iii) a display interface within said console housing for interfacing said games console to a display; (iv) a user interface within said console housing for receiving user input; (v) a game controller within said console housing for receiving game data from said game interface and said user input from said user interface and for generating therefrom game video data for output to said display interface; (vi) an adaptor interface within said console housing for coupling the games console with said adaptor unit; (vii) a memory within the console housing for storing software modules; and (viii) a processor within the console housing for executing software modules stored in the memory.” The adaptor unit includes “(i) an adaptor housing; (ii) a memory within the adaptor housing for storing a video player software module; (iii) a video data receiver within said adaptor housing for receiving encoded video data from a remote video provider; (iii) a games console interface within said adaptor housing for interfacing said adaptor unit to said adaptor interface of said games console; and (iv) a communications controller within said adaptor housing for controlling communications between the adaptor unit and said games console via said games console interface and said adaptor interface.” The obviousness rejection of claim 1 is clear error because neither Marsh, Hauppauge, nor the combination thereof disclose or fairly suggest the “game controller” sub-element of the “games console” element or the “memory” sub-element of the “adaptor unit”

element. The reasons for obviousness of claim 1 stated in the Office Action do not cure these errors because they do not explicitly state how these aspects would have been obvious based on Marsh, Hauppauge, or the combination thereof.

As for the "game controller" sub-element, the Office Action does not cite Hauppauge for disclosure of this sub-element. The Office Action cites col. 5, line 64 - col. 6, line 16 and FIG. 2 of Marsh for disclosure of the "game controller" sub-element. However, the cited portions of Marsh merely disclose data processors of a computer that are programmed by instructions stored at different times in various storage media of the computer. The Marsh computer may be programmed via various methods and techniques. Certain sub-components of the Marsh computer may be programmed to perform certain functions and steps.

Notably, the cited portions of Marsh do not disclose or fairly suggest a games system with a games console that includes a game controller that generates game video data based on received game data and received user input as recited in the "game controller" sub-element to the "games console" element of claim 1. Rather, the cited portions of Marsh simply disclose a basic computer with sub-components that may be programmed for certain functions. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the "game controller" sub-element. The reasons for obviousness do not cure this error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

As for the "memory" sub-element, this sub-element was added to claim 1 in this amendment. Therefore, the new "memory" sub-element is not directly addressed in the Office Action. Limitations similar to those presented in the "memory" sub-element were previously presented in claim 7. Claim 7 depends from claim 1 and was identified as being directed to allowable subject matter. Additionally, limitations similar to those presented in the "memory" sub-element were previously presented in a "video player" sub-element of the "games console" element of claim 1. The previously presented "video player" sub-element is deleted in this amendment. This argument for the "memory" sub-element also addresses the Office Action citations for the previously presented "video player" sub-element. Like the "game controller" sub-element, the Office Action cited col. 5, line 64 - col. 6, line 17 of Marsh for disclosure of the

previously presented "video player" sub-element. Therefore, the disclosures of Marsh identified above in the arguments distinguishing the "game controller" sub-element also apply to arguments distinguishing the "memory" sub-element.

Notably, the cited portions of Marsh do not disclose or fairly suggest a games system with an adaptor unit that includes a memory for storing a video player software module as recited in the "memory" sub-element of claim 1. Rather, the cited portions of Marsh simply disclose a basic computer with sub-components that may be programmed for certain functions. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the "memory" sub-element. The reasons for obviousness do not cure this error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

Based at least on the foregoing, it is submitted that claim 1 is patentably distinguished from the combination of Marsh and Hauppauge. Accordingly, the Applicant respectfully submits that independent claim 1 and claims dependent thereon (e.g., claims 2-4, 6, and 8-10) are currently in condition for allowance.

**Claims 11-13, 15, and 16 Patentably Distinguish Over the Combination of Marsh and Hauppauge.**

As amended, independent claim 11 is directed to an adaptor unit "an adaptor housing; a memory within the adaptor housing for storing a video player software module; a video data receiver within the adaptor housing for receiving encoded video data from a remote video provider; a games console interface within said adaptor housing for interfacing said adaptor unit to said games console; and a communications controller within said adaptor housing for controlling communications between the adaptor unit and said games console via said games console interface." The obviousness rejection of claim 11 is clear error because neither Marsh, Hauppauge, nor the combination thereof disclose or fairly suggest the "memory" element. The reasons for obviousness of claim 11 stated in the Office Action do not cure this error because they do not explicitly state how this aspect would have been obvious based on Marsh, Hauppauge, or the combination thereof.

As for the "memory" element, this element was added to claim 11 in this amendment. Therefore, the new "memory" element is not directly addressed in the Office Action. Limitations similar to those presented in the "memory" element were previously presented in previously presented claim 14. Claim 14 depends from claim 11 and was identified as being directed to allowable subject matter. Additionally, limitations similar to those presented in the "memory" element were previously presented in a "video player" sub-element of a "games console" element of claim 11. The previously presented "video player" sub-element is deleted in this amendment. This argument for the "memory" element also addresses the Office Action citations for the previously presented "video player" sub-element. The Office Action cited col. 5, line 64 – col. 6, line 17 of Marsh for disclosure of the previously presented "video player" sub-element. This portion of Marsh was identified above in the arguments distinguishing the "game controller" sub-element to the "games console" element of claim 1. Therefore, the disclosures of Marsh identified above in the arguments distinguishing the "game controller" sub-element of claim 1 also apply to arguments distinguishing the "memory" element of claim 11.

Notably, the cited portions of Marsh do not disclose or fairly suggest an adaptor unit that includes a memory for storing a video player software module as recited in the "memory" element of claim 11. Rather, the cited portions of Marsh simply disclose a basic computer with sub-components that may be programmed for certain functions. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the "memory" element. The reasons for obviousness do not cure this error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

Based at least on the foregoing, it is submitted that claim 11 is patentably distinguished from the combination of Marsh and Hauppauge. Accordingly, the Applicant respectfully submits that independent claim 11 and claims dependent thereon (e.g., claims 12, 13, 15, and 16) are currently in condition for allowance.



**Claim 21 Patentably Distinguishes Over the Combination of Marsh and Hauppauge.**

As amended, independent claim 21 is directed to a method that includes "interfacing an adaptor unit with a games console via a games console interface associated with the adaptor unit and an adaptor interface associated with the games console; receiving game data associated with a game product at the games console; receiving user input at the games console; outputting a video player software module from the adaptor unit to the games console through the games console interface and adaptor interface; receiving at the games console the video player software module; executing the video player software module on the games console; receiving at said adaptor unit encoded video data from a remote video provider; outputting encoded video data from said adaptor unit to said games console through said games console interface and the adaptor interface; decoding in said games console said encoded video data using the video player software module to generate decoded video data; generating game video data based at least in part on the received game data and the received user input; and outputting the decoded video data and the game video data via a display interface associated with the games console to a display." The obviousness rejection of claim 21 is clear error because neither Marsh, Hauppauge, nor the combination thereof disclose or fairly suggest the first "receiving" element, the first "outputting" element, the third "receiving" element, the "executing" element, the "decoding" element, the "generating" element, or the third "outputting" element. The reasons for obviousness of claim 21 stated in the Office Action do not cure these errors because they do not explicitly state how these aspects would have been obvious based on Marsh, Hauppauge, or the combination thereof.

As for the first "receiving" element, the Office Action does not cite Hauppauge for disclosure of this element. The Office Action cites col. 4, line 47 - col. 5, line 10 and FIG. 2 of Marsh for disclosure of the "receiving" element. However, the cited portions of Marsh merely disclose data processors of a computer with various types of storage devices accessible by various types of bus structures. Controllers provide for storage and retrieval of data from the Marsh storage devices.

Notably, the cited portions of Marsh do not disclose or fairly suggest a method that includes receiving game data associated with a game product at a games console as recited in the first "receiving" element of claim 21. Rather, the cited portions of Marsh simply disclose a basic computer with storage devices with basic controllers for storage and retrieval of data. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the first "receiving" element. The reasons for obviousness do not cure this error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

As for the first "outputting" element, the third "receiving" element, and the "executing" element, these elements were added to claim 21 in this amendment. Therefore, the new "outputting," "receiving," and "executing" elements are not directly addressed in the Office Action. Limitations similar to those presented in these new elements were previously presented in a "video player" element of claim 17. The previously presented "video player" element of claim 17 is deleted in this amendment. This argument for the new elements addresses the Office Action citations for the previously presented "video player" element of claim 17. The Office Action cited col. 5, line 64 – col. 6, line 17 of Marsh for disclosure of the previously presented "video player" element of claim 17. Therefore, the disclosures of Marsh identified above in the arguments distinguishing the first "receiving" element also apply to arguments distinguishing the first "outputting" element, the third "receiving" element, and the "executing" element.

Notably, the cited portions of Marsh do not disclose or fairly suggest a method that includes outputting a video player software module from an adaptor unit to a games console, receiving the video player software module at the games console, or executing the video player software module on the games console as recited in first "outputting" element, the third "receiving" element, and the "executing" element of claim 21. Rather, the cited portions of Marsh simply disclose a basic computer with sub-components that may be programmed for certain functions. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the first "outputting" element, the third "receiving" element, or the "executing" element. The reasons for obviousness do not cure these

errors because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

As for the "decoding" element, the Office Action does not cite Hauppauge for disclosure of this element. The Office Action cites col. 13, lines 46-67 of Marsh for disclosure of the "decoding" element. However, the cited portions of Marsh merely disclose a computer with a decoder module that provides secure communications by encrypting decoded content. The Marsh decoder module forwards the encrypted content to a rendering device via a content renderer module. The Marsh content renderer module decrypts the encrypted content for the rendering device.

Notably, the cited portions of Marsh do not disclose or fairly suggest a method that includes decoding encoded video data using a video player software module to generate decoded video data as recited in the "decoding" element of claim 21. Rather, the cited portions of Marsh disclose encryption and decryption of generic content. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the "decoding" element. The reasons for obviousness do not cure this error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

As for the "generating" element, the Office Action does not cite Hauppauge for disclosure of this element. The Office Action cites col. 3, lines 46-67 and FIG. 1 of Marsh for disclosure of the "generating" element. However, the cited portions of Marsh merely disclose an entertainment system with a media content rendering system that includes a display device. The Marsh media content rendering system may be a gaming console. A receiver associated with the Marsh media content rendering system receives and renders media content from multiple programming sources.

Notably, the cited portions of Marsh do not disclose or fairly suggest a method that includes generating game video data based on received game data and user input as recited in the "generating" element of claim 21. Rather, the cited portions of Marsh merely disclose a gaming console that renders media content from multiple programming sources. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the "generating" element. The reasons for obviousness do not cure this

error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

As for the third "outputting" element, the Office Action does not cite Hauppauge for disclosure of this element. The Office Action cites col. 3, lines 46-67 and FIG. 1 of Marsh for disclosure of the "outputting" element. These portions of Marsh were also cited in the Office Action in relation to the "generating" element of claim 21. Therefore, the disclosures of Marsh identified above in the arguments distinguishing the "generating" element also apply to arguments distinguishing the third "outputting" element.

Notably, the cited portions of Marsh do not disclose or fairly suggest a method that includes outputting decoded video data and game video data to a display as recited in the third "outputting" element of claim 21. Rather, the cited portions of Marsh merely disclose a gaming console that renders media content from multiple programming sources. Therefore, it is error to rely on the cited portions of Marsh for disclosure of the third "outputting" element. The reasons for obviousness do not cure this error because they do not explicitly state how this element would have been obvious based on Marsh, Hauppauge, or any combination thereof.

Based at least on the foregoing, it is submitted that claim 21 is patentably distinguished from the combination of Marsh and Hauppauge. Accordingly, the Applicant respectfully submits that independent claim 21 is currently in condition for allowance.

**Claim 5 Patentably Distinguishes Over the Combination of Marsh, Hauppauge, and Kim.**

Claim 5 depends from claim 4, which in turn depends from claim 3, which in turn depends from claim 2, which in turn depends from independent claim 1. Accordingly, claim 5 is patentably distinct from the combination of Marsh, Hauppauge, and Kim for at least the same reasons provided above distinguishing claims 1-4 from the combination of Marsh and Hauppauge. Based at least on the foregoing, the Applicant respectfully submits that claim 5 is currently in condition for allowance.

### CONCLUSION

For the reasons detailed above, it is respectfully submitted all claims remaining in the application (Claims 1-25) are now in condition for allowance. The foregoing comments do not require unnecessary additional search or examination.

☒ Remaining Claims, as delineated below:

| (1) FOR            | (2) CLAIMS REMAINING AFTER<br>AMENDMENT LESS HIGHEST NUMBER<br>PREVIOUSLY PAID FOR | (3) NUMBER EXTRA |
|--------------------|--|------------------|
| TOTAL CLAIMS       | 25   | - 21 = 4         |
| INDEPENDENT CLAIMS | 4  | - 4 = 0          |

☒ This is an authorization under 37 CFR 1.136(a)(3) to treat any concurrent or future reply, requiring a petition for extension of time, as incorporating a petition for the appropriate extension of time.

☒ The Commissioner is hereby authorized to charge any filing or prosecution fees which may be required, under 37 CFR 1.16, 1.17, and 1.21 (but not 1.18), or to credit any overpayment, to Deposit Account Number 06-0308.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to telephone Alan C. Brandt, at 216.363.9000.

Respectfully submitted,

Fay Sharpe LLP

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Date



Alan C. Brandt, Reg. No. 50,218  
The Halle Building, 5th Floor  
1228 Euclid Avenue  
Cleveland, Ohio 44115-1843  
216.363.9000